

In support of her position the examiner cited *In re Orita*, 550 F2d 1277, 193 USPQ 145 (CCPA 1977).

In re Orita

In *Orita*, there was a restriction requirement pursuant to 35 USC §121, the applicant made an election, later cancelled the non-elected claims and forgot to file a divisional patent application for the non-elected invention (claims). In *Orita*, the **error relied upon** was that the applicant forgot to file a divisional application. In *Orita*, the Board held:

that, under the circumstances of this case, failure to file a timely divisional application cannot be corrected by reissue.

at 147, 148. The CCPA affirmed. An important reason why the CCPA affirmed was that if they did not affirm but permitted a reissue, then copendency requirement would become meaningless, see [3] at 149. This decision makes good legal sense and the applicant's attorney does not disagree with it.

Facts Of The Present Case

The facts of the present case are almost the opposite of *Orita* and clearly distinguish it from *Orita*. In *Orita* the subject matter sought to be recovered by reissue was claimed and subject to a restriction requirement. In the present case the subject matter sought to be recovered by reissue was ***never*** claimed and there was **NO** restriction requirement. The Examiner in her Office Action of 00-7-11, page 4, the first two lines acknowledges there was no restriction requirement in the present patent application.

Case Law **MORE RELEVANT** Than *Orita*

Since *Orita* dealt with the situation where there was a restriction requirement relating to subject matter already claimed and in the present

situation the subject matter of claims 9-12 was never claimed in the parent case nor was there a restriction requirement, there is more relevant case law than *Orita*.

The public policy of §251 was well stated in *In re Willingham*, 127 U.S.P.Q. 211 (CCPA 1960). The Court stated:

The reissue provisions of the Patent Act of 1952, like the reissue provisions of the earlier patent statutes are remedial in nature. They are based on fundamental principles of equity and fairness and should be so applied to the facts in any given case that justice will be done both to the patentee and to the public.

This governing principle was stated way back in 1832 by Chief Justice Marshall in *Joseph Grant et al v. E. & H. Raymond*, 6 Peters 217:

The great object and intention of the [Patent] act is, to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals, for the time and labor devoted to these discoveries, by the exclusive right to make, use and sell the things discovered, for a limited time. That which give complete effect to this object and intention, by employing the same means for the correction of inadvertent error, which are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act. ...

If, by an innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, an to appropriate the discovery, without paying the stipulated consideration.

The Closest Case Law – *In re Swartzel*

In a case much more recent and relevant than *Orita*, *In re Swartzel*, 36 U.S.P.Q.2d 1510 (Fed. Cir 1995) the applicant claimed a process for ultrapasteurizing a liquid whole egg product. The reissue

application sought to add product and product by process claims. The Examiner rejected the product and product by process claims under §251.

In *In re Swartzel*, in the parent patent application the applicant had tried to add product by process claims to the process claims and the Examiner refused to enter the amendment. In the reissue the applicant's attorney entered a declaration that established that he misunderstood the scope of the product by process claims and had had he understood, he would not have filed the amendment, see 1512, column 2. Never-the-less the Examiner rejected the product by process claims in the reissue because:

... Swartzel had surrendered the opportunity to obtain product claims when he failed to file a divisional application ... in response to an examiner's refusal to enter a proposed amendment containing product by process claims.

Swartzel at 1511.

The Board affirmed the Examiner's rejection because the examiner's refusal to enter the product by process claims in the application was "tantamount" to a restriction requirement and that by not filing a divisional application, Swartzel had intentionally surrendered the product by process claims.

The Federal Circuit by Judge Archer stated at 1512:

..., §251 is a remedial statute that is to be interpreted liberally. *Weiler*, 790 F.2d at 1579, 229 U.S.P.Q. at 675

Judge Archer then, at 1512, went on to cite from *Scripts Clinic & Research found. V. Genetech, Inc.*, 927 F2d. 1565, 1575, 18 U.S.P.Q.2d 1001, 1009 (Fed. Cir. 1991) stating:

... the purpose of the reissue statute is to avoid forfeiture of substantive rights due to error made without intent to deceive.

In reversing the Board and Examiner, the Federal Circuit stated:

An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents. ... The board based its decision affirming the rejection of the claims ... on ... Swartzel's failure to file a divisional after the examiner refused entry of his amendment precluded recapture of any subject matter in that amendment. Because we conclude that such a per se rule against reissue is inappropriate and because we conclude Swartzel's declaration establishes "error without deceptive intention: correctable under 35 U.S.C. §251, we reverse. (emphasis added)

In *In re Swartzel* the applicant:

- (1) was aware that the product by process was novel and inventive,
- (2) tried to claim the product by process,
- (3) had the claims rejected on procedural grounds informing him they could not be prosecuted in the parent application and that a divisional/continuation was required for the product by process claims and
- (4) did not file the necessary application yet the Federal Circuit reversed.

The **present situation is even a MUCH MORE COMPELLING case for reissue:**

- (1) during prosecution of the parent application the applicant was unaware that the four compound of claims 9-12 were important or novel and inventive,
- (2) the applicant never tried to claim the four compounds,
- (3) the applicant never had any notice from anyone regarding the importance and patentability of the four compounds.

As stated by Judge Archer, this is a classic case of:

An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents

Given the fact that the applicant never tried to claim these four compounds, there was no Office Action regarding these four compound, no restriction requirement, absolutely no action regarding them, public policy dictates that the applicant should be able to claim these four compounds. *In re Swartzel* is much more relevant case law than *In re Orita*. Following *In re Swartzel* claims 9-12 should be allowed.

II. Conclusion

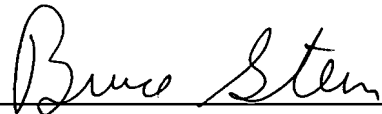
Reconsideration and allowance of claims 9-12 is requested.

Respectfully,

PHARMACIA

Date: 00-9-10

By



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